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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,415	12/03/2003	Wen-Shan Huang	3313-1076P	8785

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EXAMINER

WARREN, DAVID S

ART UNIT	PAPER NUMBER
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2837

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,415

Applicant(s)

HUANG ET AL.



Examiner

David S. Warren

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/3/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/3/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unno et al. (6,076,063). Regarding claims 1 and 8, Unno discloses the use of a first transmission interface (9), a recording medium (8), a format converting module (elements 2, 4, and 5 taken together), and a second data transmission interface (this is inherent if the converted data is to be stored on the semiconductor memory 8). The “compression” of Unno requires less storage space. Unno discloses a “small light weight” device, the Examiner maintains this to be synonymous with “portable.” Regarding claims 2 and 9, Unno discloses the use of a control module (elements 2 and 5 taken together), a decoding module (4), and a buffer unit (6). Regarding claims 3 and 10, Unno discloses the use of a display (11) and a user control (col. 7, lines 22 – 25; the use of “keys” are functionally equivalent to providing for user control). Regarding claims 4 and 11, Unno discloses the use of the use of DSP (digital signal processing) chips are well-known within the audio compression art and are shown by Unno (col. 5, first paragraph; the Examiner acknowledges that Unno uses the DSP for a different purpose). Regarding claims 5, 6, 12, 13, and 16 – 18, Unno discloses the use of PCMCIA interfaces and memory cards (col. 9, lines 46 – 55). Regarding claims 14, 15,

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and 19, the use of USB and IDE interfaces are notoriously well-known. Official Notice is hereby taken that USB and IDE interfaces are well-known and within the scope of one of ordinary skill in the art. Regarding claims 7 and 20, Unno discloses the use of a flash memory card (18). Unno does not disclose the exact arrangement of parts (i.e., the first and second data transmission interfaces, the format converting module, nor the use of PCMCIA interfaces for both the first and second data transmission interfaces).

However, Unno does disclose the use of all components and uses an arrangement that accomplish precisely same task (converting music audio formats and saving the result) as the Applicant. Therefore, the Examiner deems the teachings of Unno and the Applicant's claims to be functionally equivalent. It would have been obvious to one of ordinary skill in the art to modify the teachings of Unno to obtain Applicant's claimed arrangement of elements. The motivation for making this modification is to provide circuit design layout compatible with manufacturing optimization and protocol (as well as providing a digital circuit capable of efficient processing). Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Information Disclosure Statement

The prior art submitted by the Applicant on the IDS (December 3, 2003) was considered only in so far as possible without an English translation. The drawings of the submitted prior art, while relevant, do not appear to show or disclose the Applicant's invention.

Conclusion


3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Kubota ('186) and the publication to Leapman (2002/0105861) obviate Applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 571-272-2076. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on 571-272-2001 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dsw


MARLON T. FLETCHER
PRIMARY EXAMINER